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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stephen Dossick, M.D.

Serial Nos. 75/714,344; 75/714,345; and 75/754,818

Erin M. Falk of Sonnenschein Nath & Rosenthal for Stephen Dossick, M.D.

J. Brett Golden, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

Before Cissel, Hairston and Walters, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 2, 1999, applicant, a United States citizen who lives in California, filed the above-referenced applications to register the marks MP3JAPAN and MP3NEWYORK on the Principal Register for services in International Class 42 which were subsequently identified by amendment as follows¹:

Providing on-line magazines, newsletters, directories and books in the field of music, entertainment, arts

¹ Applications S.N.s 75/754,818 and 75/714,345, respectively.

and culture, videos, motion pictures, film, radio, television, news, current events, health and lifestyles, and sporting events; providing search engines for obtaining data on a global computer network in the field of music, entertainment, arts and culture, videos, motion pictures, film, radio, television, news, current events, health and lifestyles, and sporting events; providing on-line computerized databases in the field of arts and culture, news, current events and health and lifestyles.

In a separate application², applicant also sought registration of the MP3NEWYORK mark for services in Class 38 which were subsequently identified by amendment as follows:

Broadcasting programs via a global computer network; providing on-line chat rooms and on-line electronic bulletin boards for transmission of messages among computer users concerning music, entertainment, arts and culture, videos, motion pictures, film, radio, television, news, current events, health and lifestyles, and sporting events.

The basis for filing each of these applications was applicant's assertion that he possessed a bona fide intention to use each mark in commerce in connection with the services identified in each application.

The applications which are the subject of this appeal are but three of the twenty-two such applications filed by applicant for related marks intended to be used in connection with similar services. The other marks are all

² S.N. 75/714,344.

combinations of the term MP3 with the names of another city or continent, e.g., MP3SANFRANCISCO, MP3SEOUL, MP3SINGAPORE, MP3AMSTERDAM, MP3BERLIN, MP3BOSTON and MP3AFRICA. The Board's January 18, 2003 ruling consolidated the three applications listed in the heading of this opinion. Applicant was allowed to file separate briefs and reply briefs in each case. The remaining nineteen applications were suspended pending our resolution of this consolidated appeal.

The issues in all three appeals are essentially the same, and the records in the applications are similar. The most notable exception is the recitation of the Class 38 services in the record of that application for MP3NEWYORK.

In each application on appeal, the Examining Attorney has refused registration under Sections 2(e)(1), 2(e)(2) and 2(e)(3) of the Lanham Act on alternative grounds. He contends that these marks are either merely descriptive or deceptively misdescriptive of the recited services within the meaning of Section 2(e)(1) of the Act and/or that the marks are either primarily geographically descriptive of the services within the meaning of Section 2(e)(2) of the Act or they are primarily geographically deceptively misdescriptive of them within the meaning of Section 2(e)(3) of the Act.

In addition to refusing registration in the initial Office Actions, the original Examining Attorney³ made of record listings from a geographical dictionary establishing that Japan is the name of the well-known island country in the western Pacific and that New York is the name for both the state and the city in the northeastern United States. She also made of record an Internet encyclopedia listing which establishes that MP3 is the computer format into which audio files are compressed for transmission over computer networks such as the Internet. Copies of several excerpts from articles published in the United States refer to Internet and/or computer-related businesses located in New York and Japan.

Responsive to the initial refusals to register, applicant stated that its services may in fact originate, at least in part, in Japan and New York, respectively. Applicant went on to explain that its business plan will likely allow for local offices in Japan and New York to render the claimed services from those locations. Additionally, in response to the inquiries of the Examining Attorney, applicant admitted that some of its audio content may be transmitted using MP3 technology.

³ Examining Attorney Golden took over for Examining Attorney Saito at the briefing stage.

With regard to the application which relates to services in Class 38, applicant stated that its chat room and bulletin board services, as well as its broadcasting services, could use MP3 technology and could cover issues or information related to New York, although applicant does not intend to so limit its services or the technology used to render them.

The Examining Attorney also made of record excerpts of articles published in the United States which demonstrate that Internet content providers render their services from Japan and from New York, and that Internet chat room and broadcasting services also originate there.

The test under Section 2(e)(1) of the Lanham Act for determining whether a mark is merely descriptive of the goods or services with which it is, or will be, used is well settled. This section of the Act precludes registration of a mark if it merely describes a quality, characteristic, function or feature of the relevant services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re MetPath Inc., 223 USPQ 88 (TTAB 1984). The same section of the statute also provides that a mark may be refused registration if it conveys information concerning a quality, characteristic, function or feature of the services that is false, but plausible. In re

Woodward & Lothrop Inc., 4 USPQ2d 1412 (TTAB 1987). It is not necessary for the term in question to describe all of the qualities, characteristics, functions or features of the services in order for a refusal under Section 2(e)(1) to be appropriate. It is sufficient if a term describes one significant attribute of them. In re MBAssociates, 180 USPQ 338 (TTAB 1973). The fact that the term sought to be registered does not appear in the dictionary is not determinative of the issue of mere descriptiveness. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). A mark is suggestive, rather than merely descriptive, if imagination, thought or perception is required to reach a conclusion as to the characteristics of the services. In re Shutts, 217 USPQ 363 (TTAB 1983).

When these legal principles and the ones governing geographical descriptiveness and geographical misdescriptiveness are considered in conjunction with the records in the cases before us, we find that the Examining Attorney has adequately supported the refusals to register based on mere descriptiveness and geographical descriptiveness, but that in view of the fact that applicant has stated that its services will involve providing information relating to Japan and New York, the refusals based on misdescriptiveness under Section 2(e)(1)

of the Act are not well taken, and in view of applicant's concession that his services will be rendered in Japan and New York, that the marks are not primarily geographically misdescriptive within the meaning of Section 2(e)(3) of the statute.

As noted above, these records support the conclusion that two significant features or characteristics of applicant's Class 42 services of providing on-line publications, search engines and computerized databases in the fields of music, entertainment, arts and culture, etc., are that some of the information applicant will make available to its customers will be transmitted in the MP3 computer format, and that the subject of some of the information thus disseminated will be Japan or New York. With regard to the application involving broadcasting services, on-line chat rooms and on-line electronic bulletin boards, the record in that application is clear that at least some of the information transmitted by applicant will be in the MP3 format, and that the subject of at least some of the programming provided by applicant and the discussions provided in applicant's chat rooms and on applicant's electronic bulletin boards will relate to music, entertainment, arts and culture in New York.

When the commonly-understood meanings of the terms MP3, JAPAN and NEW YORK are considered in the two combinations presented by these marks, the resulting compound terms clearly communicate the facts that the services will involve the transmission of information about Japan and New York, respectively, in the MP3 format. These are significant characteristics or features of these services.

Applicant argues that the terms it seeks to register are arbitrary, fanciful, unitary marks with absolutely no meanings. Applicant contends they are at most suggestive, requiring mental gymnastics and multi-step reasoning in order to glean any meaning from them. Applicant repeatedly points out that the records contain no dictionary definitions for MP3JAPAN or MP3NEWYORK and that the Examining Attorney has not made of record any evidence that anyone has used or needs to use these terms in connection with any services.

Applicant's arguments are not persuasive. We cannot adopt applicant's conclusion that the Examining Attorney has not met his burden of proof. As noted above, he has demonstrated the meanings of MP3, Japan and New York, and he has explained why consumers presented with MP3JAPAN or MP3NEWYORK in connection with applicant's Internet-based

services which will include providing information about Japan or New York in the MP3 format would understand MP3JAPAN or MP3NEWYORK to describe that fact.

Contrary to applicant's contention, the combinations of these descriptive terms do not result in new, unitary, compound marks which are incongruous or have some non-descriptive meaning. As the Examining Attorney points out, in relation to applicant's online publications, search engines and databases in the field of music, entertainment, arts and culture, the only reasonable interpretation of the marks are the descriptive ones identified by the Examining Attorney. The same thing applies in regard to the services in Class 38.

Even applicant could not conjure up other possible connotations for these marks, although he did argue that coming up with what is to us the obvious descriptive meaning of the combination of the two elements in each mark could only be achieved through a complicated, multi-step reasoning process. We simply disagree. We can find no support in this record for concluding that prospective purchasers of these services would need to use any imagination, mental gymnastics or complex reasoning in order to impute the ordinary meanings to the components of these marks and arrive at the descriptive meaning in which

the combination of the two descriptive component terms naturally results. The marks identify significant characteristics or features of the services recited in the applications, namely that the information which will be available by means of applicant's on-line publications, search engines and computer databases, and the subjects of its broadcasts, chat rooms and on-line bulletin boards, will relate to Japan or to New York, and that this information will be transmitted in the MP3 format. Accordingly, the marks are unregistrable under Section 2(e)(1) of the Act.

That the record does not show that the terms applicant seeks to register have a dictionary definition or have been used by someone else in connection with the services set forth in these applications does not mandate a different result. In *re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977).

In view of the fact that the services will involve information about Japan and New York, the refusals based on misdescriptiveness in the context of Section 2(e)(1) of the Lanham Act are plainly not appropriate. If the information provided in applicant's publications and computer databases were not going to concern Japan or New York, those refusals might have been proper, but applicant's concession that

information about Japan or New York may be what is transmitted in the MP3 format renders the refusals based on misdescriptiveness inappropriate because the information about the services provided by the marks would not be false.

We thus turn to the second pair of alternative refusals, based on the Examining Attorney's holdings that the marks are either primarily geographically descriptive within the meaning of Section 2(e)(2) of the Act or that they are primarily geographically deceptively misdescriptive under Section 2(e)(3). In view of applicant's statement that its services will likely be rendered by local offices in Japan and New York, respectively, the latter basis for the refusals appears to be inappropriate, but the record establishes that the refusals under Section 2(e)(2) of the Act are proper.

Neither applicant nor the Examining Attorney seriously disputes the test for registrability under Section 2(e)(2). To establish a prima facie case for refusing registration of a mark because it is primarily geographically descriptive, the Examining Attorney must show: (1) that the primary significance of the mark is geographic; (2) that purchasers would be likely to make an association between the goods or services and the place named in the mark; and

(3) that the services do, or will, in fact, come from that place. In re California Pizza Kitchen, 10 USPQ2d 1704 (TTAB 1989); In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982). The addition of a generic or merely descriptive term to one which is primarily geographically descriptive does not avoid the refusal under Section 2(e)(2) of the Act. In re JT Tobacconists, 59 USPQ2d 1080 (TTAB 2001); In re Wine Society of America Inc., 12 USPQ2d 1139 (TTAB 1989). The issue remains whether the primary significance of the mark is geographic, and, if the services do in fact emanate from the place named in the mark, the services/place association can be presumed. In re Carolina Apparel, 48 USPQ2d 1542 (TTAB 1998).

In the case at hand, the Examining Attorney has clearly met his burden of establishing that the marks applicant seeks to register are primarily geographically descriptive within the meaning of Section 2(e)(2) of the Act. As noted above, the records establish that Japan and New York are the names of well-known places which are neither remote nor obscure, that Internet-based services are rendered by companies located in those places, and that applicant intends to render its services from the locations named in the marks. Plainly, consideration of these marks would lead prospective purchasers of applicant's services

to understand that applicant's services are, or will be, rendered from Japan or New York, respectively. Each element of the test for registrability under Section 2(e)(2) has thus been satisfied.

Applicant argues against these refusals to register by repeating the unpersuasive argument discussed above. It centers on applicant's contention that the marks are unitary, arbitrary, coined terms with no meanings. As noted above, however, the readily understood meanings of the component terms which make up the marks would result in prospective purchasers of applicant's services understanding significant characteristics or features of the services.

Certainly, it is likely that the descriptive significance of these marks discussed above would be recognized by a portion of prospective purchasers of these services, but others are just as likely to understand from the marks that Japan and New York are the places where the services are performed. Again, applicant has proposed no significance the mark could have that is not either merely descriptive or primarily geographic.

As noted above, combining the geographic designations with the descriptive term MP3 does not obviate the refusals on the grounds that the marks are primarily geographically

descriptive. MP3 is a generic term for the audio format. It does not alter the primary geographic significance of the mark as a whole.

In his brief, applicant makes an interesting argument with regard to the nature of services rendered by means of the Internet. Applicant espouses the theory that even if purchasers would understand Japan and New York as place names and MP3 as the name of the format in which applicant's information files will be available, purchasers would still not make the requisite services/place associations because no specific location is known for these Internet-based services; because the location from which such services are actually rendered is insignificant; and because all that purchasers know or need to know is that they are available on line. Applicant argues that "[t]o think that Internet services originate from any specific geographic location is a fiction," because his services "could originate from servers anywhere in the world..." (brief, p. 18).

We are not persuaded by applicant's argument because, as this record clearly demonstrates, the public is aware that Internet-related services are rendered by businesses located in the geographic locations identified in the marks, and applicant itself plans on rendering his services

from the places named in the marks. Moreover, it would be unreasonable to adopt the conclusion that purchasers of these kinds of services do not think that they are rendered from somewhere. It seems much more likely that users of global computer networks, even though they may be unaware of the precise physical locations of the entities at the other ends of their network communications, recognize the fact that the wires and cables that constitute the networks do, in fact, lead somewhere, and that the entities which conduct business on these networks to have physical embodiments somewhere. If there were any fiction involved in this analysis, it would be adopting applicant's assertion that purchasers somehow believe that these services somehow spring directly from the ether in the Ethernet with no discernible origin.

If applicant's on-line publication, database and search engine services were not going to originate in Japan and New York, the refusals under Section 2(e)(3) would be appropriate, but in view of applicant's admission that they will be rendered from the named places, the refusals under Section 2(e)(2) are well taken.

In summary, the refusals under Section 2(e)(1) and Section 2(e)(2) of the Lanham Act are affirmed because the marks are merely descriptive of applicant's services and

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the marks are primarily geographically descriptive of them as well. In view of the fact that the specified services will be rendered in the locations named in the marks, and the fact that the subject matters of the online publications, search engines and databases, as well as the chat rooms, broadcasts and bulletin boards, will be information about Japan and New York, respectively, the refusals to register based on misdescriptiveness and geographical misdescriptive are not appropriate.

DECISION: The refusals to register under Section 2(e)(1) based on mere descriptiveness and under Section 2(e)(2) based on geographical descriptive this are affirmed. The refusals based on misdescriptiveness this under Section 2(e)(1) and on geographical misdiscriptiveness under Section 2(e)(3) are reversed.